

ESTTA Tracking number: **ESTTA730890**

Filing date: **03/02/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	7-Eleven, Inc.
Granted to Date of previous extension	03/02/2016
Address	3200 Hackberry Road Irving, TX 75063 UNITED STATES
Attorney information	Steven M. Espenshade Pirkey Barber PLLC 600 Congress Avenue, Suite 2120 Austin, TX 78701 UNITED STATES tmcentral@pirkeybarber.com, smeleen@pirkeybarber.com, sespen-shade@pirkeybarber.com, eolson@pirkeybarber.com

Applicant Information

Application No	86628500	Publication date	11/03/2015
Opposition Filing Date	03/02/2016	Opposition Period Ends	03/02/2016
Applicant	Giorgifred Company Farmers Bank Building, Suite 1414 Wilmington, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Prepared entrees consisting primarily of meat and cheese; prepared entrees, namely, batter-dipped foods consisting primarily of meat and cheese

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1688000	Application Date	11/16/1989
Registration Date	05/19/1992	Foreign Priority Date	NONE

Word Mark	BREAKFAST BITE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1989/02/20 First Use In Commerce: 1989/02/20 SANDWICHES; NAMELY, SAUSAGES AND BUNS FOR CONSUMPTION ON OR OFF THE PREMISES


U.S. Registration No.	1708496	Application Date	09/16/1991
Registration Date	08/18/1992	Foreign Priority Date	NONE
Word Mark	SPICY BITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1990/03/12 First Use In Commerce: 1990/03/12 sandwiches; namely, hot dogs and buns		

U.S. Registration No.	2099249	Application Date	09/09/1996
Registration Date	09/23/1997	Foreign Priority Date	NONE
Word Mark	1/4 POUND BIG BITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1989/01/00 First Use In Commerce: 1989/01/00 sandwiches, namely, hot dogs and buns for consumption on or off the premises		

U.S. Registration No.	2560037	Application Date	04/21/2000
Registration Date	04/09/2002	Foreign Priority Date	NONE
Word Mark	BIGGEST BIG BITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2000/04/30 First Use In Commerce: 2000/04/30 sandwiches, namely hot dogs and buns for consumption on or off the premises		

U.S. Registration No.	2780103	Application Date	04/20/2001
Registration Date	11/04/2003	Foreign Priority Date	NONE

Word Mark	BIG BITE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 sandwiches, namely hot dogs and buns for consumption on or off the premises

U.S. Registration No.	4425418	Application Date	03/25/2013
Registration Date	10/29/2013	Foreign Priority Date	NONE
Word Mark	BIG BITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2011/08/31 First Use In Commerce: 2011/08/31 Potato chips		

Attachments	76031492#TMSN.png(bytes) 76244724#TMSN.png(bytes) 85885824#TMSN.png(bytes) 7ELV043 - CHEESEBURGER BITE - Notice of Opposition - Final.pdf(25753 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/SME/
Name	Steven M. Espenshade
Date	03/02/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Serial No. 86/628,500	§	
Filed: May 13, 2015	§	
Mark: GIORGIO CHEESEBURGER BITES	§	
Published: November 3, 2015	§	
	§	
7-Eleven, Inc.,	§	
	§	Opposition No. _____
Opposer,	§	
	§	
v.	§	
	§	
Giorgifred Company.	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

Opposer 7-Eleven, Inc. (“Opposer”) believes that it will be damaged by registration of the mark identified above for the goods recited in Class 29, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer is a Texas corporation with a principal place of business at 3200 Hackberry Road, Irving, Texas 75063.
2. For decades, Opposer has been engaged in the business of offering convenience store services and various products to the general public at locations across the United States, and Opposer currently operates over 7,500 stores within the United States.
3. Since at least as early as 1995, Opposer and its predecessors in interest have used the mark CHEESEBURGER BITE (the “CHEESEBURGER BITE Mark”) in association with sandwiches, including sandwiches consisting primarily of meat and cheese.
4. In addition to the CHEESEBURGER BITE Mark, Opposer has for many years used other marks incorporating the term “BITE” with sandwiches and other food products, including the marks

BIG BITE, 1/4 POUND BIG BITE, BIGGEST BIG BITE, BREAKFAST BITE, and SPICY BITE (collectively, the “7-Eleven Bite Marks”).

5. Opposer has for years widely advertised and promoted its sandwiches sold under the CHEESEBURGER BITE Mark and its sandwiches and other food products sold under the 7-Eleven Bite Marks to consumers across the United States through a variety of different means, including on signage located within Opposer’s stores and on its website at the domain www.7-eleven.com. As a result of such efforts, the CHEESEBURGER BITE Mark and the 7-Eleven Bite Marks have become widely recognized and well-known as a designation of the products offered by Opposer.

6. Opposer’s CHEESEBURGER BITE Mark and 7-Eleven Bite Marks are inherently distinctive, serving to identify and indicate the source of Opposer’s goods to the consuming public, and to distinguish Opposer’s goods from those of others.

7. Additionally, as a result of Opposer’s decades of use and promotion of its CHEESEBURGER BITE Mark and 7-Eleven Bite Marks, these mark have become distinctive and are recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting its CHEESEBURGER BITE Mark, its 7-Eleven Bite Marks, and the goods sold under these marks, with the result that the purchasing public has come to know, rely on, and recognize the goods of Opposer by these marks. Opposer has established valuable goodwill in its CHEESEBURGER BITE Mark and its 7-Eleven Bite Marks.

8. The CHEESEBURGER BITE Mark is famous pursuant to 15 U.S.C. § 1125.

9. The 7-Eleven Bite Marks are famous pursuant to 15 U.S.C. § 1125.

10. In addition to its extensive common-law rights, Opposer is the owner of the following United States Trademark Registrations covering its 7-Eleven Bite Marks:

Trademark	Registration No.	Goods/Services	Date Issued
BREAKFAST BITE	1,688,000	030 – Sandwiches, namely, sausages and buns for consumption on or off the premises.	5/19/1992
SPICY BITE	1,708,496	030 – Sandwiches, namely, hot dogs and buns.	8/18/1992
1/4 POUND BIG BITE	2,099,249	030 - Sandwiches, namely, hot dogs and buns for consumption on or off the premises	9/23/1997
BIGGEST BIG BITE	2,560,037	030 - Sandwiches, namely hot dogs and buns for consumption on or off the premises	4/9/2002
BIG BITE	2,780,103	030 - Sandwiches, namely hot dogs and buns for consumption on or off the premises	11/4/2003
BIG BITE	4,425,418	029 – Potato chips	11/29/2013

Each registration listed in the chart above is valid and subsisting, and Registration Nos. 1,688,000, 1,708,496, 2,099,249, 2,560,037, and 2,780,103 are incontestable.

11. Applicant Giorgifred Company (“Applicant”) is a Delaware corporation with a principal place of business at Farmers Bank Building, Suite 1414, 301 N. Market Street, Wilmington, Delaware 19801.

12. Applicant filed Application Serial No. 86/628,500 (the “Application”) on May 13, 2015 for the mark GIORGIO CHEESEBURGER BITES (the “GIORGIO CHEESEBURGER BITES Mark”) on the basis of Applicant’s intent to use the GIORGIO CHEESEBURGER BITES Mark with the goods “*Prepared entrees consisting primarily of meat and cheese; prepared entrees, namely, batter-dipped foods consisting primarily of meat and cheese*” in International Class 29.

13. Opposer commenced use of its CHEESEBURGER BITE Mark in the United States prior to the filing date of the Application, and Opposer's use of the CHEESEBURGER BITE Mark has been continuous since it commenced use of the mark.

14. Opposer has priority based on its prior use of the CHEESEBURGER BITE Mark in the United States.

15. Opposer has priority based on its prior use and registration of its 7-Eleven Bite Marks in the United States.

16. Applicant's GIORGIO CHEESEBURGER BITES Mark is confusingly similar to Opposer's CHEESEBURGER BITE Mark, and the goods in the Application are directly competitive with, or similar or related to, the goods for which Opposer has used its CHEESEBURGER BITE Mark.

17. Applicant's GIORGIO CHEESEBURGER BITES Mark is confusingly similar to Opposer's 7-Eleven Bite Marks, and the goods in the Application are directly competitive with, or similar or related to, the goods for which Opposer has used and registered its 7-Eleven Bite Marks.

18. Applicant's goods travel in the same or similar channels of trade as Opposer's goods, and are or will be purchased and used by the same or similar types of consumers who purchase and use Opposer's goods.

19. Opposer has not given Applicant permission or approval to use or register the GIORGIO CHEESEBURGER BITES Mark.

20. Applicant's GIORGIO CHEESEBURGER BITES Mark so resembles Opposer's CHEESEBURGER BITE Mark as to be likely, when used on or in connection with the identified goods of the Application, to cause confusion, or to cause mistake, or to deceive. Registration therefore should be refused under 15 U.S.C. § 1052(d).

21. Applicant's GIORGIO CHEESEBURGER BITES Mark so resembles Opposer's 7-Eleven Bite Marks as to be likely, when used on or in connection with the identified goods of the Application, to cause confusion, or to cause mistake, or to deceive. Registration therefore should be refused under 15 U.S.C. § 1052(d).

22. Opposer's CHEESEBURGER BITE Mark became famous within the United States prior to the filing date of the Application.

23. Applicant's GIORGIO CHEESEBURGER BITES Mark is likely to cause dilution to the distinctive quality of Opposer's famous CHEESEBURGER BITE Mark, and registration should also be refused under 15 U.S.C. § 1125(c).

24. Opposer's 7-Eleven Bite Marks became famous within the United States prior to the filing date of the Application.

25. Applicant's GIORGIO CHEESEBURGER BITES Mark is likely to cause dilution to the distinctive quality of Opposer's famous 7-Eleven Bite Marks, and registration should also be refused under 15 U.S.C. § 1125(c).

26. Registration of Applicant's GIORGIO CHEESEBURGER BITES Mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations and common law, and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 86/628,500 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber PLLC, Account No. 50-3924/7ELV043/SPM, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: March 2, 2016

/Steven M. Espenshade/
Steven M. Espenshade
Stephen P. Meleen
PIRKEY BARBER PLLC
600 Congress Avenue, Suite 2120
Austin, Texas 78701
(512) 322-5200
ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served via First Class Mail, postage pre-paid, upon Applicant's listed correspondent at the address below, on March 2, 2016:

Bassam N. Ibrahim
Buchanan Ingersoll & Rooney PC
Suite 500
1737 King Street
Alexandria, Virginia 22314

/Steven M. Espenshade/
Steven M. Espenshade